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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,070	11/09/2001	Deanna Michelle Woods		5237

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CATALINA & ASSOCIATES
167 AVENUE AT THE COMMON
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SHREWSBURY, NJ 07702

EXAMINER

CHIN, RANDALL E

ART UNIT	PAPER NUMBER
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1744

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/041,070

Applicant(s)

WOODS ET AL.

Examiner

Randall Chin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2004 and 15 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 5-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 16-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 09012004
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claim 8 is objected to because of the following informalities: On line 8, after "to", insert --the--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Gallanty '029.

The patent to Gallanty '029 teaches a sanitary toothbrush comprising a handle 10 having an upper surface, a lower surface, a distal end, a proximal end, and an elongated intermediate portion therebetween, the distal end of the handle having a brush unit generally comprised of a rectangular head portion (since Gallanty '029 recites that the **cross-section** of the handle can be of rectangular shape in col. 3, lines 13-15) adjacent and integral thereto, the head portion having an upper surface with a plurality of bristle tufts 11 extending outward therefrom, and the **entire** proximal end of the handle generally comprised of a curved shape in the form of a hook 12, the curved proximal end being of sufficient size, dimension and radius to allow for the hanging or suspension of the toothbrush in an upside down position.

In response to claim 1 reciting that the curved proximal end is of sufficient size, dimension and radius to allow for hanging or suspension of the toothbrush in an upside down position, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Note, in Gallanty '029, the hook portion at 12 is semi-circular in shape (col. 3, lines 11-13) and is therefore deemed to be of sufficient size, dimension and radius to allow for the hanging or suspension of the toothbrush in an upside down position. Clearly, Gallanty's toothbrush as shown in Figs. 1 and 4 is **capable of** being hung in an upside down position.

As for claim 2, the curved proximal end of the handle extends outward in a direction that is opposite the bristle tufts (Fig. 1).

4. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Barnes '579.

The patent to Barnes '579 teaches a sanitary toothbrush comprising a handle 1 having an upper surface, a lower surface, a distal end, a proximal end, and an elongated intermediate portion in between, the distal end of the handle having a brush unit at extremity 5 generally comprised of a rectangular head portion (Fig. II) adjacent

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and integral thereto, the head portion having an upper surface with a plurality of bristle tufts 6 (Fig. III) extending outward therefrom, and the **entire** proximal end of the handle generally comprised of a curved shape in the form of a finger rest or hook 2 (col. 2, lines 57-60), the curved proximal end being deemed of sufficient size, dimension and radius to allow for the hanging or suspension of the toothbrush in an upside down position.

Although Barnes' toothbrush is actually hung or suspended through the use of a hole 3 in the hook 2 (Figs. I and IV), Barnes '579 still meets the recited language of claim 1 notwithstanding this means of hanging or suspension. Moreover, it will be pointed out that Barnes' toothbrush could well be hung in the manner of Applicant's invention simply because of Barnes' hook structure (Fig. I). Additionally, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Note, Barnes' toothbrush is deemed to be of sufficient size, dimension and radius to allow for the hanging or suspension of the toothbrush in an upside down position. Clearly, Barnes' toothbrush as shown in Figs. I and V is **capable of** being hung in an upside down position.

As for claim 2, the curved proximal end of the handle extends outward in a direction that is opposite the bristle tufts (Fig. I).

Claim Rejections - 35 USC § 102

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1 and 2 are rejected under 35 U.S.C. 102(a) as being anticipated by Harada '546.

The patent to Harada '546 teaches a sanitary toothbrush in Fig. 8 comprising a handle having an upper surface, a lower surface, a distal end, a proximal end, and an elongated intermediate portion in between, the distal end of the handle having a brush unit at 801 generally comprised of a rectangular head portion (Fig. 8) adjacent and integral thereto, the head portion having an upper surface with a plurality of bristles tufts 107 (col. 5, lines 54-58) extending outward therefrom, and the **entire** proximal end of the handle generally comprised of a curved shape in the form of a hook (Fig. 1) for hanging the toothbrush, the curved proximal end being of sufficient size, dimension and radius to allow for the hanging or suspension of the toothbrush in an upside down position. Note, the "entire proximal end" of the handle is being defined simply as the right-hand portion of the C-shaped section (Fig. 1) and the "elongated intermediate portion" can simply be the left-hand portion of the C-shaped section (Fig. 1). It will be pointed out that Harada's toothbrush could well be hung in the manner of Applicant's invention. Additionally, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim

drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Note, Harada's toothbrush is deemed to be of sufficient size, dimension and radius to allow for the hanging or suspension of the toothbrush in an upside down position.

As for claim 2, the curved proximal end of the handle extends outward in a direction that is opposite the bristle tufts (Fig. 1).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3, 4 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnes '579 in view of Enriquez '386.

The patent to Barnes '579 discloses all of the recited subject matter as recited above with the exception of the elongated intermediate portion being "designed and shaped" to represent a tailed animal. Enriquez '386 teaches a toothbrush comprising an elongated intermediate portion "designed and shaped" to represent a tailed animal.

Given this teaching, it would have been obvious to one of ordinary skill in the art to have modified Barnes' handle such that just the **elongated intermediate portion** is designed and shaped to represent a tailed animal as suggested by Enriquez '386 to

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make the toothbrush more aesthetically pleasing to users, particularly children. In any case, Enriquez '386 has simply been applied as a secondary reference to teach that the elongated intermediate portion can be "designed and shaped" to represent a tailed animal. The primary or base reference to Barnes '579 already teaches that the curved entire proximal end (i.e., the "tail") can be used for hanging or suspension purposes.

As for claim 4, absent any **specific structural features of the monkey** shown in Fig. 5 being claimed (e.g., ears, circular head, two legs grasping the handle, etc.), claim 4 is not deemed patentable over the above combined teachings to Barnes and Enriquez. It will be noted that with respect to the specific feature of the tail as recited in claims 3 and 4, Barnes' hook, as defined above, is deemed to be "**designed and shaped**" to represent a tailed animal (claim 3) and is also deemed to be "**designed and shaped**" as a monkey's tail (claim 4). This language does not actually require there to be any animal disclosed in Barnes but merely that there be some structural element in Barnes (e.g., a hook) that is "**designed and shaped**" as an animal's tail or a monkey's tail. Clearly, Barnes' curved finger rest or hook is "**designed and shaped**" to represent a tailed animal or a monkey's tail which tends to be curved in form. This is all that is required of claims 3 and 4.

Note also that merely reciting the word "monkey" in claim 4 does not make claim 4 allowable over the combined teachings of Barnes and Enriquez simply because Enriquez does not show a monkey but just an alligator. Again, claim 4 lacks **specific structural features of the monkey as shown by Fig. 5** being claimed (e.g., ears, circular head, two legs grasping the handle, etc.). It should also be noted that the mere

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fact that Applicant's other dependent claims recite numerous different animals such as a snake, alligator, dinosaur, dolphin, etc., does not necessarily imply certain specific structural features of these respective animals into the claims for patentability purposes.

The claims must define the **specific structural features of the specific animals** to be entitled patentable significance. The present language of claim 4 referring broadly that the intermediate portion of the handle is designed and shaped as a "monkey" is merely deemed to involve an aesthetic design feature or change. The Examiner will not read particular structural features into the claim when only the term "monkey" has been recited as in claim 4. The court found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229. 73 USPQ 431 (CCPA 1947). Thus, the recitation that the "designed and shaped animal represented in the intermediate portion of the handle is a monkey" merely involves an aesthetic design feature or change merely relating to ornamentation having no mechanical function. The tail, shaped for a hanging function, has been addressed by the Examiner previously.

Enriquez, it should be noted, is a U.S. design patent, properly classified in designs since it shows a toothbrush having an intermediate portion "designed and shaped" as an animal (i.e., alligator). The mere fact that Enriquez has been classified in designs demonstrates it's purely ornamental function. For the term "monkey" or any other animal for that matter to be accorded patentable significance in apparatus claims or in a utility patent, the claim(s) must recite specific structural features of the particular animal being claimed.

As for new claims 16-18, these claims are similarly rejected as already explained. It will be added, however, that Barnes' hook or "tail" "defines the shape of a feature of the animal".

8. Claims 3, 4 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gallanty '029 in view of Enriquez '386.

The patent to Gallanty '029 discloses all of the recited subject matter as recited above with the exception of the elongated intermediate portion being "designed and shaped" to represent a tailed animal. Enriquez '386 teaches a toothbrush comprising an elongated intermediate portion "designed and shaped" to represent a tailed animal.

Given this teaching, it would have been obvious to one of ordinary skill in the art to have modified Gallanty's handle such that just the elongated intermediate portion is designed and shaped to represent a tailed animal as suggested by Enriquez '386 to make the toothbrush more aesthetically pleasing to users, particularly children. In any case, Enriquez '386 has simply been applied as a secondary reference to teach that the elongated intermediate portion can be "designed and shaped" to represent a tailed animal. The primary or base reference to Gallanty '029 already teaches that the curved entire proximal end (i.e., the "tail") can be used for hanging or suspension purposes.

As for claim 4, absent any **specific structural features of the monkey** shown in Fig. 5 being claimed (e.g., ears, circular head, two legs grasping the handle, etc.), claim 4 is not deemed patentable over the above combined teachings to Gallanty and Enriquez. It will be noted that with respect to the specific feature of the tail as recited in

claims 3 and 4, Gallanty's hook, as defined above, is deemed to be "**designed and shaped**" to represent a tailed animal (claim 3) and is also deemed to be "**designed and shaped**" as a monkey's tail (claim 4). This language does not actually require there to be any animal disclosed in Gallanty but merely that there be some structural element in Gallanty (e.g., a hook) that is "**designed and shaped**" as an animal's tail or a monkey's tail. Clearly, Gallanty's curved finger rest or hook is "**designed and shaped**" to represent a tailed animal or a monkey's tail which tends to be curved in form. This is all that is required of claims 3 and 4.

Note also that merely reciting the word "monkey" in claim 4 does not make claim 4 allowable over the combined teachings of Gallanty and Enriquez simply because Enriquez does not show a monkey but just an alligator. Again, claim 4 lacks **specific structural features of the monkey as shown by Fig. 5** being claimed (e.g., ears, circular head, two legs grasping the handle, etc.). It should also be noted that the mere fact that Applicant's other dependent claims recite numerous different animals such as a snake, alligator, dinosaur, dolphin, etc., does not necessarily imply certain specific structural features of these respective animals into the claims for patentability purposes. The claims must define the **specific structural features of the specific animals** to be entitled patentable significance. The present language of claim 4 referring broadly that the intermediate portion of the handle is designed and shaped as a "monkey" is merely deemed to involve an aesthetic design feature or change. The Examiner will not read particular structural features into the claim when only the term "monkey" has been recited as in claim 4. The court found that matters relating to ornamentation only which

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have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229. 73 USPQ 431 (CCPA 1947). Thus, the recitation that the “designed and shaped animal represented in the intermediate portion of the handle is a monkey” merely involves an aesthetic design feature or change merely relating to ornamentation having no mechanical function. The tail, shaped for a hanging function, has been addressed by the Examiner previously. Enriquez, it should be noted, is a U.S. design patent, properly classified in designs since it shows a toothbrush having an intermediate portion “designed and shaped” as an animal (i.e., alligator). The mere fact that Enriquez has been classified in designs demonstrates it’s purely ornamental function. For the term “monkey” or any other animal for that matter to be accorded patentable significance in apparatus claims or in a utility patent, the claim(s) must recite specific structural features of the particular animal being claimed.

As for new claims 16-18, these claims are similarly rejected as already explained. It will be added, however, that Barnes’ hook or “tail” “defines the shape of a feature of the animal”.

Conclusion

9. Applicant's arguments filed June 29, 2004 have been fully considered but they are not persuasive.

Addressing Applicant's arguments regarding Barnes '579, the Examiner respectfully disagrees with Applicant. Barnes '579 teaches a curved shape at the

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proximal end in the form of a finger rest or hook 2 (col. 2, lines 57-60), the curved proximal end being deemed of sufficient size, dimension and radius to allow for the hanging or suspension of the toothbrush in an upside down position. The mere fact that Barnes' hook 2 is for a finger rest does not mean this hook structure cannot perform any other function. Such matters involve intended use. It would be the same if Barnes explicitly taught that the hook was for hanging the toothbrush upside down. Then it would follow then that Barnes' hook could also be used a finger rest as such matters merely involve intended use. The issue is not what Barnes may explicitly recite or teach in the patent for the finger rest structure but what Barnes' structure is "capable of" achieving or carrying out. Again, such issues merely involve intended use. The U-shaped hook or partially U-shaped hook of Barnes is deemed **capable of** hanging the toothbrush in an upside down position. If Barnes' hook structure is of a perfect U-shape, then it is clearly capable of being hung upside down. Assuming arguendo it was only partially U-shape, then it might still be capable of being hung upside down. Furthermore, there are numerous types of hooks available out in the market that could still permit Barnes' partially U-shape hook to be hung in an upside down position (e.g., rubber covered hooks to prevent slippage). In any case, the Examiner deems it unnecessary to further argue this point. The mere fact that Barnes' is explicitly silent as to hanging the brush by this U-shaped feature does not render Barnes incapable of hanging solely by the U-shaped hook structure. Also, the mere fact that Barnes may not explicitly mention a "hook" structure is irrelevant. Such "hook" is clearly shown in Figs. I and V. Barnes is deemed capable of being hung in an upside down manner. Although Barnes recites that

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the toothbrush is actually hung or suspended through the use of a hole 3 in the hook 2 (Figs. I and IV), Barnes '579 still meets the recited language of claim 1 notwithstanding this means of hanging or suspension. The mere fact of this explicit teaching of Barnes does not render Barnes moot for purposes of rejecting claims 1 and 2. Claim 1 calls simply for a hook for hanging the toothbrush upside down and Barnes teaches a "hook" structure of sufficient size, dimension and radius capable of accomplishing this function.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references to Angelillo and Maltese are relevant to brushes with hook arrangements.

11. Any inquiry concerning this communication or earlier communication from the Examiner should be directed to Randall Chin whose telephone number is (571) 272-1270. The Examiner can normally be reached on Monday through Thursday and every other Friday.

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Robert Warden, can be reached at (571) 272-1281. The number for Technology Center 1700 is (571) 272-1700.

The central fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



R. Chin



Randall Chin
Primary Examiner
Art Unit 1744